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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/092,317

03/06/2002

Jeremy Barker

4858-000357

9021

33204

7590

10/23/2003

VALENCE TECHNOLOGY, INC.
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EXAMINER

TSANG FOSTER, SUSY N

ART UNIT

PAPER NUMBER

1745

7

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS7

Office Action Summary

Application No.

10/092,317

Applicant(s)

BARKER ET AL.

Examiner

Susy N Tsang-Foster

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 4,9,10,17,18,31-39,44 and 51 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-25,42,49 and 52-60 is/are allowed.
- 6) ☒ Claim(s) 1-3,5-8,11-16,26-30,40,41,43,45-48 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,6. 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species I and the Fe species in Paper No. 5 is acknowledged.

Since no prior art was found against the elected species readable on claims 19-25, 42, 49, and 52-60, a search was extended for Species II as listed in the previous written restriction requirement and the Mn subspecies as M' that is readable on claims 1-3, 5-8, 11-16, 26-30, 40, 41, 43, 45-48, and 50.

2. Claims 4, 9, 10, 17, 18, 31-39, 44, and 51 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

Response to Amendment

3. This Office Action is responsive to the amendment filed on 7/28/2003. Claim 19 has been amended. Claims 52-60 have been added. Claims 1-60 are pending. Claims 19-25, 42, 49, and 52-60 are allowed. Claims 4, 9, 10, 17, 18, 31-39, 44, and 51 are withdrawn from further consideration as being drawn to a non-elected invention. Claims 1-3, 5-8, 11-16, 26-30, 40, 41, 43, 45-48, and 50 are rejected for reasons given below.

Specification

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The abstract of the disclosure is objected to because it appears to contain more than 150 words and it uses the word "said". Correction is required. See MPEP § 608.01(b).

Duplicate Claims

6. Applicant is advised that should claim 29 be found allowable, claim 30 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claim 47 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 47, the limitation "said second electrode comprises a metal oxide, metal chalcogenide, carbon, graphite, and mixtures thereof" is indefinite because it is unclear if the second electrode comprises all these materials or one of these materials or mixtures thereof. For the purposes of prosecution, claim 47 is interpreted as "said second electrode comprises one of a metal oxide, metal chalcogenide, carbon, graphite, and mixtures thereof."

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-3, 5-8, 11-16, 26-30, 40, 41, 43, 45-48, and 50 are rejected under 35 U.S.C. 102(a) as being anticipated by EP 1094533 A1.

EP 1094533 A1 discloses a lithium battery comprising a first electrode comprising a positive electrode active material with the formula $\text{Li}_x(\text{Mn},\text{Mg})_y\text{PO}_4$ where $0 < x \leq 2$ and 0.8

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$y \leq 1.2$, a negative electrode comprising one of lithium metal, lithium alloy, carbon material, and a metal oxide, and an electrolyte between the positive and negative electrodes (see paragraphs 16, 27, 32, and 33). The positive electrode also contains the positive electrode active material, a binder and an electrically conductive carbonaceous material (paragraphs 53 and 81).

11. Claims 1-3, 5-8, 11-16, 26-30, 40, 41, 43, 45-48, and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 00/60680 A (equivalent document EP 1094533 A1 relied upon for translation).

The equivalent EP 1094533 A1 document for WO 00/60680 A discloses a lithium battery comprising a first electrode comprising a positive electrode active material with the formula $\text{Li}_x(\text{Mn,Mg})_y\text{PO}_4$ where $0 < x \leq 2$ and $0.8 \leq y \leq 1.2$, a negative electrode comprising one of lithium metal, lithium alloy, carbon material, and a metal oxide, and an electrolyte between the positive and negative electrodes (see paragraphs 16, 27, 32, 33 of EP 1094533 A1). The positive electrode also contains the positive electrode active material, a binder and an electrically conductive carbonaceous material (paragraphs 53 and 81 of EP 1094533 A1).

12. Claims 1-3, 5-8, 11-16, 26-30, 40, 41, 43, 45-48, and 50 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Barker et al. (US 2003/0077514 A1).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37

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CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See abstract; paragraphs 6-12 of the reference.

Allowable Subject Matter

13. Claims 19-25, 42, 49, and 52-60 are allowed.


Conclusion

Any inquiry concerning this communication or earlier communications should be directed to examiner Susy Tsang-Foster, Ph.D. whose telephone number is (703) 305-0588. The examiner can normally be reached on Monday through Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached at (703) 308-2383. The phone number for the organization where this application or proceeding is assigned is (703) 305-5900.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

st/ 

Susy Tsang-Foster
Primary Examiner
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